REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application. Claims 1-8 are now present in this application. No new matter has been added by way of the present amendment. For instance, claims 1-5 have been amended to correct indefiniteness issues, in accordance with the Examiner's request of August 9, 2006. Accordingly, no new matter has been added.

In view of the amendments and remarks herein, Applicants respectfully request that the Examiner withdraw all outstanding rejections and allow the currently pending claims.

Claim Objections

Claim 6 stands objected to under 37 C.F.R. § 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim. This objection is respectfully traversed.

It is noted that Applicants filed a Preliminary Amendment on September 23, 2005, wherein this informality was corrected. Accordingly, this objection is moot.

Reconsideration and withdrawal thereof are thus respectfully requested.

Issues Under 35 U.S.C. §112, second paragraph

Claims 1-5 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. This rejection is respectfully traversed.

The Examiner asserts that the phrases "these aliphatic or alicyclic groups" and "7-(Alkynylamino)triazolopyrimidines" in claim 1 and the word "compounds" in claims 2-5 are indefinite.

Applicants have amended claims 1-5 to more clearly define the subject matter claimed. Accordingly, this rejection is moot.

Applicants respectfully request reconsideration and withdrawal of this rejection.

Issues Under 35 U.S.C. § 103(a)

Claims 1, 3-5 and 7-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pees (U.S. 5,965,561) (hereinafter Pees '561). This rejection is respectfully traversed.

The Examiner asserts that Pees '561 discloses pentafluorophenylazolopyrimidines that show fungicidal activity which include compounds, compositions and methods of use "embraced in the instant claims". The Examiner further asserts that the compound of formula I of Pees '561 is similar to that of the instant invention when R^1 is an alkyl group and R^2 is an alkynyl group. Further, the Examiner asserts that the compounds taught by Pees '561 "generally include the instant genus of compounds".

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Instant formula (I) represents one of an extremely large number of compounds encompassed by the generic formula (I) of Pees '561. It is well settled that a genus does not always anticipate a claim to a species within the genus. A compound is anticipated only when one of ordinary skill in the art is able to "at once envisage" the specific compound within the generic chemical formula. *In re Petering*, 301 F.2d 676, 133 USPQ 275 (CCPA 1962). For a compound to be "at once envisaged", one of ordinary skill in the art must be able to draw the structural formula or write the name of each of the compounds included in the generic formula. *Id.* In the instant case, groups "R^1" and "R^2" in Pees '561 can each be hydrogen, alkyl, alkynyl, alkadienyl, aryl, bicycloalkyl or heterocyclyl. Optionally, these groups could further be substituted or may form a ring. Pees '561 does not provide any example specifically utilizing Applicants' formula (I), nor in any other way suggest this specific formula. Furthermore, Pees '561 discloses preferred embodiments, none of which lists alkynyl as a preferred R^1 or R^2 group (see col. 4, lines 7-10 and 20-47). In particular, where compounds with a good fungicidal activity are listed, alkynyl is not mentioned (see col. 5, lines 16-39). Further, no specific synthetic pathway leading to alkynyl compounds is disclosed in Pees '561.

Evidently, the specific formula (I) of the instant invention can not be "at once envisaged" from the generic formula (I) of Pees '561. Accordingly, due to the vast number of compounds covered by the generic formula (I) of Pees '561, this formula clearly can not render obvious Applicants' formula (I). For this reason alone, this rejection should be withdrawn.

Furthermore, Pees '561 provides no motivation or suggestion to specifically utilize Applicants' formula (I). Applicants have discovered that the inventive formula (I) of the present invention exhibits remarkable activity against *Puccinia Recondita*. Pees '561 is absolutely silent about *Puccinia Recondita*. Furthermore, not only does Pees '561 fail to disclose activity against *Puccinia Recondita*, but the very broad list of possible phytopathogenic target fungi disclosed by Pees '561 at col. 5, lines 3-11 does not even include rust diseases in general.

Because Applicants' invention, as set forth in claims 1, 3-5 and 7-8, is not disclosed or made obvious by the cited prior art, reconsideration and withdrawal of this rejection are respectfully requested.

Double Patenting Issues

U.S. 6,559,151

Claims 1-5 and 7-8 stand rejected under the judicially created doctrine of nonstatutory double patenting. The Examiner asserts that these claims are in conflict with claims 1-8 of "Liu, United States Patent No. 6,559,151". This rejection is respectfully traversed.

It is initially noted that U.S. 6,559,151, issued to Pees et al., and not "Liu". Applicants assume that the mention of Liu is a typographical error. The following comments are directed to Pees '151.

It is respectfully submitted that the instant invention is patentably distinct from the teachings of Pees '151. Instant formula (I) represents one of an extremely large number of compounds encompassed by the generic formula (I) of claim 1 of Pees '151. For instance, groups "R^1" and "R^2" in Pees '151 can independently be hydrogen, alkyl, alkenyl, alkynyl, alkadienyl,

haloalkyl, cycloalkyl, bicycloalkyl, phenyl, naphtyl, heterocyclyl or heteroaryl. Optionally, these groups could further be substituted, unsubstituted, may be partially or fully halogenated or may carry additional groups. It is well settled that a genus does not always anticipate a claim to a species within the genus. A compound is anticipated only when one of ordinary skill in the art is able to "at once envisage" the specific compound within the generic chemical formula. *In re Petering*, 301 F.2d 676, 133 USPQ 275 (CCPA 1962). For a compound to be "at once envisaged", one of ordinary skill in the art must be able to draw the structural formula or write the name of each of the compounds included in the generic formula. *Id.* Pees '151 does not provide any example specifically utilizing Applicants' formula (I), nor in any other way suggest this specific formula. Furthermore, Pees '151 discloses preferred embodiments, none of which list alkynyl as a preferred R^1 or R^2 group.

Evidently, the specific formula (I) of the instant invention can not be "at once envisaged" from the generic formula (I) of Pees '151. Accordingly, due to the vast number of compounds covered by the generic formula (I) of Pees '151, this formula clearly can not render obvious Applicants' formula (I).

Applicants respectfully submit that claims 1-5 and 7-8 are patentably distinct from claims 1-8 of Pees '151. Accordingly, the Examiner is requested to reconsider and withdraw his findings of double patenting.

U.S. Application Number 10/513,030

The Examiner asserts that claims 1-5 and 7-8 stand provisionally rejected under the judicially created doctrine of double patenting over claims 1-2 and 6-8 of copending application Serial No. 10/513,030. This rejection is respectfully traversed.

Initially, it is noted that Application Number 10/513,030 matured into Patent Number 7,094,894 on August 22, 2006 (hereinafter Blasco '894).

It is respectfully submitted that the instant invention is patentably distinct from the teachings of Blasco '894. Instant formula (I) represents one of an extremely large number of compounds encompassed by the generic formula (I) of claim 1 of Blasco '894. For instance, groups "R^1" and "R^2" in Blasco '894 can independently be hydrogen, alkyl, alkynyl, alkenyl, alkadienyl, haloalkyl, cycloalkynyl, phenyl, naphtyl, or an aromatic heterocycle. Optionally, these groups could further be substituted, unsubstituted and may form rings. It is well settled that a genus does not always anticipate a claim to a species within the genus. A compound is anticipated only when one of ordinary skill in the art is able to "at once envisage" the specific compound within the generic chemical formula. *In re Petering*, 301 F.2d 676, 133 USPQ 275 (CCPA 1962). For a compound to be "at once envisaged", one of ordinary skill in the art must be able to draw the structural formula or write the name of each of the compounds included in the generic formula. *Id.* Blasco '894 does not provide any example specifically utilizing Applicants' formula (I), nor in any other way suggest this specific formula. Furthermore, Blasco '894 discloses preferred embodiments, none of which list alkynyl as a preferred R^1 or R^2 group.

Evidently, the specific formula (I) of the instant invention can not be "at once envisaged" from the generic formula (I) of Blasco '894. Accordingly, due to the vast number of compounds

covered by the generic formula (I) of Blasco '894, this formula clearly can not render obvious Applicants' formula (I).

Applicants respectfully submit that claims 1-5 and 7-8 are patentably distinct from claims 12 and 6-8 of Blasco '894. Accordingly, the Examiner is requested to reconsider and withdraw his findings of double patenting.

U.S. Application Numbers 10/523,719, 10/483,597, and 10/483,600

Claims 1-5 and 7-8 stand provisionally rejected under the judicially created doctrine of double patenting over copending application Serial Nos. 10/523,719, 10/483,597 and 10/483,600. These rejections are respectfully traversed.

Initially, it is noted that the obviousness-type double patenting rejection is merely "provisional" at this stage. According to MPEP §804 I.B., if this is the only issue remaining in this application, the claims in this application should be allowed without the filing of a Terminal Disclaimer. The Terminal Disclaimer could then be required in the related application.

Since neither of the involved applications has been allowed at the present time, it is respectfully submitted that it is not necessary to file a Terminal Disclaimer at this time.

U.S. Application Numbers 10/508,409 and 10/483,599

The Examiner asserts that claims 1-5 and 7-8 stand provisionally rejected under the judicially created doctrine of double patenting over claims 1, 12-13, 18 and 19 of copending application Serial No. 10/508,409, as well as claims 1-4 of copending application Serial No. 10/483,599. These rejections are respectfully traversed.

Initially, it is noted that Application Number 10/508,409 matured into Patent Number 7,148,227 on December 12, 2006 (hereinafter Blasco '227). Similarly, Application Number 10/483,599 matured into Patent Number 7,083,047 on May 2, 2006 (hereinafter Blasco '047).

It is respectfully submitted that the instant invention is patentably distinct from the teachings of Blasco '227 and Blasco '047. Instant formula (I) represents one of an extremely large number of compounds encompassed by the generic formulas claimed by Blasco '227 and Blasco '047.

As previously discussed, a genus does not always anticipate a claim to a species within the genus. A compound is anticipated only when one of ordinary skill in the art is able to "at once envisage" the specific compound within the generic chemical formula. *In re Petering*, 301 F.2d 676, 133 USPQ 275 (CCPA 1962). For a compound to be "at once envisaged", one of ordinary skill in the art must be able to draw the structural formula or write the name of each of the compounds included in the generic formula. The specific formula (I) of the instant invention can not be "at once envisaged" from the generic formulas claimed by Blasco '227 and Blasco '047. Accordingly, due to the vast number of compounds covered by the generic formulas claimed by these references, the references can not render obvious Applicants' formula (I).

Applicants respectfully submit that claims 1-5 and 7-8 are patentably distinct from claims 1, 12-13, 18 and 19 of Blasco '227, as well as claims 1-4 of Blasco '047. Accordingly, the Examiner is requested to reconsider and withdraw his findings of double patenting.

U.S. Application Number 10/474,460

The Examiner asserts that claims 2-4 stand "provisionally rejected" under 35 U.S.C. § 103(a) as being unpatentable over Blasco et al., U.S. Application Number 10/474,460 (see page 8 of the outstanding Office Action). The Examiner further asserts that this "obviousness-type double patenting rejection [is] provisional" (see page 9 of outstanding Office Action).

It is initially noted that U.S. Application Number 10/474,460 matured into Patent Number 7,105,664 to Blasco et al. on September 12, 2006 (hereinafter Blasco '664).

It is further noted that, if this rejection is indeed a double-patenting rejection, it is improper and should be withdrawn. According to M.P.E.P. §804, "the focus of any double patenting analysis necessarily is on the claims in the multiple patens or patent applications involved in the analysis". Therefore, a double patenting rejection that does not focus on the claims but instead is based on a patent or patent application in its entirety is improper and should be withdrawn.

Furthermore, it is respectfully submitted that the instant invention is patentably distinct from the teachings of Blasco '664. Instant formula (I.1) represents one of an extremely large number of compounds encompassed by the generic formula (I) of Blasco '664. As previously discussed, a compound is anticipated only when one of ordinary skill in the art is able to "at once envisage" the specific compound within the generic chemical formula. *In re Petering*, 301 F.2d 676, 133 USPQ 275 (CCPA 1962). For a compound to be "at once envisaged", one of ordinary skill in the art must be able to draw the structural formula or write the name of each of the compounds included in the generic formula. *Id.* Evidently, the specific formula (I.1) of the instant invention cannot be "at once envisaged" from the generic formula (I) of Blasco '664.

Accordingly, due to the vast number of compounds covered by the generic formula (I) of Blasco '664, this formula clearly cannot render obvious Applicants' formula (I).

Furthermore, as acknowledged by the Examiner, Blasco '664 fails to disclose that the formula comprises a halomethyl group. Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Blasco '664 fails to teach or suggest all the limitations of the instant invention. Furthermore, one skilled in the art at the time of the invention would have not been motivated to modify the generic formula of Blasco '664, which encompasses a very large number of compounds, to add a halomethyl and to further arrive at the specific compound of Applicants' formula (I.1).

Because Applicants' invention, as set forth in claims 2-4, is not disclosed or made obvious by the cited prior art, reconsideration and withdrawal of this rejection are respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and objections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Andrew D. Meikle (Reg. No. 32,868) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: January 9, 2007

Respectfully submitted,

By_____
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